

REMARKS

Claims 1-23 stand rejected. Claims 1, 2, 9, 10, 11, 12, 13, 15, 17, 18 and 21 have been amended. Claims 8 and 23 are cancelled. New claims 24-26 have been added. A typographical error has been corrected in the specification. The amendments do not add new matter and are supported by the originally filed specification.

Claims 1-7, 9-22, 24-28 are presently pending. In view of the foregoing amendments and the following remarks, Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested.

1. Rejection of claims 8, 10, and 23 (35 U.S.C. § 102(b))

Claims 8, 10, and 23 were rejected under 35 U.S.C. § 102(b), the Examiner alleging these claims are anticipated by U.S. Patent No. 5,628,684 to Bouedec ("Bouedec"). Claims 8 and 23 have been cancelled, mooted the rejections for these claims. Amended claim 10 now depends from amended claim 9. As discussed below, amended claim 9 is allowable over the cited references. Thus, the Applicant submits that amended claim 10 is allowable.

Applicant respectfully request withdrawal the 35 U.S.C. § 102(b) rejection.

2. Rejection of claims 1-7, 9, and 11-22 (35 U.S.C. § 103(a))

Claims 1-7, 9, and 11-22 stand rejected under 35 U.S.C. § 103(a), the Examiner alleging that these claims are unpatentable over Bouedec and further in view of U.S. Patent No. 5,222,624 to Burr ("Burr"). The Applicant respectfully traverses this rejection for the remaining claims and submits that the rejection should be withdrawn for at least the following reasons.

First, to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2143.03.

Applicant respectfully submits that neither Bouedec nor Burr, alone or combination, teach or suggest all the limitations of the rejected claims.

Bouedec generally describes a game system comprising an instant win game ticket, where the game ticket can be a win ticket or a lose ticket. If the game ticket is a win ticket, the win ticket may be used to initialize a game console to participate in a second game. The second game may be, for example, a video game displayed on a game console and controlled by a computer at a central site. *See, e.g.*, Bouedec Abstract. A player accesses a second game 2 by inserting a win ticket T1g into the game console where identification information D1 is read and transmitted to the central computer. Access to Bouedec's video game may be provided as a prize for a winning game ticket.

Burr generally describes a ticket dispenser machine connected to a central computer.

Applicant's new game and game system may be based on a conventional instant lottery game, such as a scratch off ticket. The instant game plays in a manner generally similar to conventional scratch-off or other instant lottery games. However, when purchasing the instant ticket, players may be presented with the option to purchase a chance to participate in an extended play portion, e.g., a video lottery game. The extended play portion may be played after the instant lottery game has been played.

Bouedec in view of Burr does not disclose all the features of Applicant's amended claim 1. Amended claim 1 recites: "a lottery ticket dispenser having a bar code reader to read the bar code on the lottery ticket prior to the lottery ticket being dispensed from the dispenser, and an input device to receive an indication from a player indicating the player's choice to participate in an interactive game" and "a central computer system in communication with the lottery ticket dispenser, wherein the indication from the player to participate in the interactive game and an interactive game information is transmitted to the central computer system." As discussed above, Bouedec generally describes transmitting D1, the identification on the win ticket T1g, to the computer C at the central site. However, Bouedec fails to describe "an indication from a player indicating the player's choice to participate in an interactive game"

or transmitting that indication to the central computer system. Nor does Burr describe or suggest such a modification. Thus, Applicant submits Bouedec in combination with Burr does not teach all the limitations of Applicant's claim 1. Therefore, claim 1 should be allowable and the obviousness rejection should be withdrawn.

Claims 2-7 depend from claim 1 and thus should be patentable over the cited references for at least the same reasons as claim 1.

Similarly, amended claim 12 recites, in relevant part, "receiving an indication from the player indicating the player's choice to participate in the interactive game." For reasons similar to those of amended claim 1 above, Applicant submits that amended claim 12 is allowable and requests withdrawal of the obviousness rejection.

Claims 13, 15-18, 21 and 22 depend from claim 12, and thus should be patentable over the cited references for at least the same reasons as claim 12.

Separately and independently, the Examiner has failed to provide a proper motivation to modify Bouedec. The Examiner's reasoning that the motivation to modify Bouedec is to provide an efficient method for distributing the lottery tickets by using an automated ticket dispensing machine utilizing the Internet is a hindsight reconstruction that has used the Applicant's claimed invention as a roadmap to pick and choose features from the cited references. To reject, the Examiner must find a suggestion to combine the references that is "clear and particular." *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for "actual evidence" of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). Because no proper motivation to combine has been provided, Applicant respectfully submits the obviousness rejection should be withdrawn.

With regards to amended claim 9, the Examiner argues it would have been obvious to modify Bouedec/Burr to include the use of the Internet as the electrical link and address codes for access to the second game to expand usage of the game. As discussed above, the Examiner has failed to present proper motivation to combine the references. Neither of the

cited references mention or even suggest the use of the Internet, as is required for a proper obviousness rejection. Thus, the Applicant respectfully submit that the improper obviousness rejection should be withdrawn.

For at least the foregoing reasons, Applicant submits that claims 1-7, 9, 11-22 are allowable and respectfully request withdrawal of all rejections.

3. New Claims 24-26

New claims 24-26 depend from claims 1 and 12. Accordingly they should be allowable over the cited art of record for at least the reasons given above for claims 1 and 12.

CONCLUSION

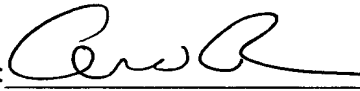
In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,

KENYON & KENYON

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